

TOWNSEND and TOWNSEND and CREW LLP

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Richard A. Darrell

Application No.: 10/615,582

Filed: July 7, 2003

For: Receipt Presentment Systems
And Methods

Customer No.: 20350

Confirmation No.: 8946

Examiner: Narayanswamy Subramanian

Art Unit: 3691

APPELLANT'S BRIEF
UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
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Sir:

Further to the "Notice Of Appeal" and "Pre-Appeal Brief Request For Review" filed May 27, 2008, and the "Notice Of Panel Decision From Pre-Appeal Brief Review" mailed June 10, 2008, for the above-referenced application, Appellant submits this Brief on Appeal.

1. Real Party In Interest

First Data Corporation of Englewood, Colorado, is the real party in interest as the assignee of the above-identified application.

2. Related Appeals And Interferences

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

3. Status Of Claims

Claims 1-5, 7, 9, 11-15, 17, 18, 21 and 23 are currently pending in the application. All pending claims stand finally rejected pursuant to a final Office Action mailed February 27, 2008. The rejection of claims 1-5, 7, 9, 11-15, 17, 18, 21 and 23 is believed to be improper and is the subject of this appeal. The claims as rejected are attached as Appendix A.

Claim 18 stands rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-5, 7, 9, 11-15, 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,397,194 to Houvener et al. ("Houvener") in view of the cited portions of U.S. Patent Publication No. 2001/0029470 to Schultz et al. ("Schultz").

Claims 21 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shultz.

4. Status Of Amendments

The claims have been amended six times in this case. An Amendment was filed March 16, 2005, in response to a non-final Office Action mailed December 16, 2004. An Amendment was filed October 31, 2005, in response to a final Office Action mailed August 31, 2005. An Amendment was filed January 9, 2006, in response to an Advisory Action mailed December 9, 2005. An Amendment was filed June 23, 2006, in response to a non-final Office Action mailed March 23, 2006. An Amendment was filed June 20, 2007, in response to a non-final Office Action mailed March 21, 2007. An Amendment was filed December 3, 2007, in response to a non-final Office Action mailed July 2, 2007. No amendments have been entered subsequent to the final Office Action mailed February 27, 2008. This Appeal Brief is filed in response to the final Office Action.

5. Summary Of Claimed Subject Matter

In the following summary, the Appellant has provided exemplary references to sections of the specification and drawings supporting the subject matter defined in the claims as required by 37 C.F.R. § 41.37. The specification and drawings also include additional support for other exemplary embodiments encompassed by the claimed subject matter. Thus, it should be appreciated that the references are intended to be illustrative in nature only.

Claim 1 recites a method of presenting an image of a receipt to a consumer depicted generally at Figure 2 and ¶¶[0028]-[0030]. The method includes electronically capturing a receipt (ref. no. 202, ¶[0028]); storing the receipt at a host computer system (ref. no. 202, ¶[0028]); receiving a request at the host computer system from a computer of the consumer to display the image of the receipt (ref. no. 204, ¶[0029]); transmitting an electronic file comprising the image of the receipt for display at the consumer computer, the electronic file further comprising programming that causes at least one purchase item included on the receipt to appear as a selectable link to obtain more detailed information about the item (ref. no. 206, ¶[0029], Fig. 3B); receiving from the consumer computer information that defines at least one user-defined category based on product information (Fig. 3D, ¶[0035]); receiving a request at the host computer from the consumer computer to display a categorical listing of items purchased by the consumer, wherein the items are comprised by a plurality of receipts (ref. no. 214, ¶[0030]); for each of the plurality of receipts, consulting a database for product information relating to each item of the receipt (ref. no. 216, ¶[0030]); using the product information to sort the items into categories comprising the at least one user-defined category (ref. no. 218, ¶[0031]); and transmitting a second electronic file from the host computer system to the consumer computer, wherein the file comprises a listing of the items sorted into categories comprising the at least one user-defined category based on product information for display at the consumer computer (ref. no. 218, Fig. 3E, ¶[0030]).

Claim 11 recites a system for presenting an image of a receipt to a consumer depicted generally at Fig. 1 and described at ¶¶[0021]-[0027]. The system includes a host computer system (102), including a product information database (106) for storing product

information that is retrievable via an identifier relating to an item; and an interface through which the host computer system communicates with at least one consumer computer (108). The host computer system is programmed to receive an electronically-captured receipt (ref. no. 202, ¶[0028]); store the receipt (ref. no. 202, ¶[0028]); receive a request from a computer of the consumer to display the image of the receipt (ref. no. 204, ¶[0029]); and transmit an electronic file comprising the image of the receipt for display at the consumer computer (ref. no. 206, ¶[0029], Fig. 3B).

Claim 18 recites a system for presenting an image of a receipt to a consumer depicted generally at Fig. 1 and described at ¶¶[0021]-[0027]. The system includes means for receiving an electronic image of a receipt (ref. no. 202, ¶[0028]); means for storing the image (106); means for receiving a request from a computer relating to the consumer to display the image (ref. nos. 102, 204, ¶[0029]; means for transmitting the image to the consumer computer (102); means for obtaining product information relating to an item on the receipt (110); and means for categorizing a plurality of items on a receipt into user-definable categories according to the product information (ref. nos. 102, 218, ¶[0031]).

Claim 21 recites a method of presenting receipt information to a consumer generally at Figure 2 and ¶¶[0028]-[0030]. The method includes receiving from a consumer computer information that defines at least one user-defined category (Fig. 3D, ¶[0035]); receiving a request at the host computer from the computer of the consumer to display a categorical listing of items purchased by the consumer, wherein the items are comprised by a plurality of receipts (ref. no. 214, ¶[0030]); for each of the plurality of receipts, consulting a database for information relating to each item of the receipt (ref. no. 216, ¶[0030]); using the information to sort the items into categories comprising the at least one user-defined category (ref. no. 218, ¶[0031]); and transmitting an electronic file from the host computer system to the consumer computer, the electronic file comprising a list of the items sorted into categories comprising the at least one user-defined category for display at the consumer computer (ref. no. 218, Fig. 3E, ¶[0030]).

6. Grounds Of Rejection To Be Reviewed On Appeal

Issue 1: Whether claim 18 was properly rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Issue 2: Whether claims 1-5, 7, 9, 11-15, 17 and 18 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,397,194 to Houvener et al. ("Houvener") in view of the cited portions of U.S. Patent Publication No. 2001/0029470 to Schultz et al. ("Schultz").

Issue 3: Whether claims 21 and 23 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Shultz.

7. Argument

Issue 1: Whether claim 18 was properly rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

The Appellant maintains that the rejection of claim 18 under 35 U.S.C. § 101 is improper. Claim 18 is denominated as a system claim ("A system for presenting an image of a receipt to a consumer . . ."). A system is statutory. The record provides no legal precedent for the rejection, other than to cite "*In re Warmerdam*, 31 USPQ2d 1754," wherein a claim to a disembodied data structure was affirmed. While this may be the case, this does not justify the pending rejection of claim 18 under 35 U.S.C. § 101. In that same case, the CAFC noted that "[c]laim 5 is for a machine, and is clearly patentable subject matter." If reviewing the instant case, the CAFC might say just as emphatically, "[c]laim 18 is for a system, as in clearly patentable subject matter." There is no other law cited in the rejection of claim 18, and the Appellant maintains that the rejection is improper.

Issue 2: Whether claims 1-5, 7, 9, 11-15, 17 and 18 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,397,194 to Houvener et al. ("Houvener") in view of the cited portions of U.S. Patent Publication No. 2001/0029470 to Schultz et al. ("Schultz").

The Appellant maintains that the rejection of claim 1 under 35 U.S.C. § 103(a) is improper because the record has not established a *prima facie* case of obviousness. Specifically, the record has not properly followed the Graham factors to arrive at a showing that all claim elements exist in the prior art and has not established the relevant skill necessary to determine that it would have been obvious to combine the references. Moreover, there is no “clear articulation of the reasons(s) why the claimed invention would have been obvious,” the “key to supporting any rejection under 35 U.S.C. 103,” according to MPEP 2141.

Herein, the Appellant specifically discussed the differences between the prior art and the claimed invention. Based on these differences, the failure of the record to address the level of skill of one in the relevant art, and the absence of the necessary “clear articulation” of the reasoning behind the rejections, the Appellant urges that the case be moved to allowance.

Claim 1 recites:

1. A method of presenting an image of a receipt to a consumer, comprising:
 - electronically capturing a receipt;
 - storing the receipt at a host computer system;
 - receiving a request at the host computer system from a computer of the consumer to display the image of the receipt;
 - transmitting an electronic file comprising the image of the receipt for display at the consumer computer, the electronic file further comprising programming that causes at least one purchase item included on the receipt to appear as a selectable link to obtain more detailed information ~~on the receipt~~ from the consumer computer information that defines at least one user-defined category based on product information;
 - receiving a request at the host computer from the consumer computer to display a categorical listing of items purchased by the consumer, wherein the items are comprised by a plurality of receipts;
 - for each of the plurality of receipts, consulting a database for product information relating to each item of the receipt;
 - using the product information to sort the items into categories comprising the at least one user-defined category; and
 - transmitting a second electronic file from the host computer system to the consumer computer, wherein the file comprises a listing of the items sorted into categories comprising the at least one user-defined category based on product information for display at the consumer computer.

The cited references do not teach or suggest “receiving from the consumer computer information that defines at least one user-defined category based on product information.” The final Office Action issued on February 27, 2008, pp. 5 and 6, states that the element need not be given patentable weight. In justifying this, the final Office Action states, “[t]he limitation ‘information that defines at least one user-defined category based on product information’ is not a positive recitation of the defining step. This limitation describes the information received from the consumer computer and not the step of receiving the information.” This makes no sense. The only way the claim element could be interpreted as not describing the step of receiving the information is because the Examiner conveniently parses the claim element to remove the “receiving” part of the claim. As the Appellant pointed out previously, the user-defined categories are usable to sort the items and, in fact, are so used, as indicated in another claim element. Hence, it is improper not to give the claim elements patentable weight.

The rejection of claim 1 is supported by a citation to “In re Lowry, 32 F.3d 1579, 32 USPQ2d 1034 (Fed. Cir. 1994),” which *overturned* the BPAI’s improper extension of a “printed matter rejection” to a new field. The CAFC would be similarly critical here, since claim 1 does not relate to printed matter. Hence, the cited law does not support the basis of the rejection.

The rejection of claim 1 also cites “In re Nagi, 367 F.3d 1336, 70 U.S.P.Q.2d (BNA) 1862 (Fed. Cir. May 13, 2004)” to support the rejection based on not giving printed matter patentable weight. Because the claim elements not given patentable weight here do not relate to “printed matter,” in response, the Appellant respectfully directs attention to In re Lowry cited above, which specifically addresses not extending printed matter rejections to new fields. Hence, neither case of record provides legal precedent supporting the rejection, and the Appellant maintains that the rejection of claim 1 is improper.

The rejection of claim 11 is believed to be improper because one of skill in the art would not be motivated to combine the references as suggested by the Examiner. Houvener teaches away from Schultz since Houvener requires paper receipts (see Houvener, col. 6, ll. 59-60) and Schultz deals exclusively with electronic environments (see, for example, the Abstract,

and paragraphs 3, 10, 29 and 31, among others, of Schultz). There is no paper receipt generated by Schultz that is compatible with the teachings of Houvener. Hence, any hint of a motivation to combine the references is destroyed by this teaching away. The rejection of claim 11 is, therefore, believed to be improper, at least for this additional reason. The rejections of claims 1 and 18 are improper for the same reason.

The Appellant also maintains that the cited references could not be successfully combined to produce a working embodiment of the invention of claim 11. Houvener relates to scanning paper receipts. Schultz deals exclusively with electronic environments. There is no receipt generated by Schultz to be scanned by Houvener. Moreover, the Office Action's attempt to explain the combination has not addressed the flaw in the argument that there is no teaching that allows Houvener to interface with Schultz, so the system produced by the combination would fail to function properly. Hence, claims 1, 11 and 18 are believed to be allowable, at least for this additional reason.

The Appellant also maintains that the rejection of claim 18 is improper. The record cites Thompson as teaching user-defined categories, yet the Office Action states that "the user-defined categories are those selected by the user." User-selected categories are not, however, user-defined categories. Having to torture the term "user-selected categories" to include "user-defined categories" is a good indication that it was improper to take official notice of the claim element. Having to cite multiple columns of a reference is another. Official Notice is not intended to be a default rejection when a claim element cannot be found in the prior art. As stated at MPEP § 2144.03,

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of **instant and unquestionable demonstration** as being well-known. (Emphasis added.)

The rejection of claim 18 is, therefore, improper.

Issue 3: Whether claims 21 and 23 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Shultz.

The rejection of claim 21 includes a number of instances in which claim elements are not given patentable weight. The rejection refers to claim 1 for foundation. Since the Appellant has addressed the shortcomings of the rejection of claim 1 above, the Appellant directs attention to those arguments to identify the shortcomings of the rejection of claim 21. Specifically, the cases cited do not support the extension of “printed matter rejections” to other fields as is being attempted here.

All remaining claims depend from an independent claim discussed herein and are believed to be allowable, at least by virtue of that dependency.

8. Conclusion

For these reasons, it is respectfully submitted that the rejections should be reversed.

Respectfully submitted,

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9. Claims Appendix

1. (Previously Presented) A method of presenting an image of a receipt to a consumer, comprising:

electronically capturing a receipt;

storing the receipt at a host computer system;

receiving a request at the host computer system from a computer of the consumer to display the image of the receipt;

transmitting an electronic file comprising the image of the receipt for display at the consumer computer, the electronic file further comprising programming that causes at least one purchase item included on the receipt to appear as a selectable link to obtain more detailed information about the item;

receiving from the consumer computer information that defines at least one user-defined category based on product information;

receiving a request at the host computer from the consumer computer to display a categorical listing of items purchased by the consumer, wherein the items are comprised by a plurality of receipts;

for each of the plurality of receipts, consulting a database for product information relating to each item of the receipt;

using the product information to sort the items into categories comprising the at least one user-defined category; and

transmitting a second electronic file from the host computer system to the consumer computer, wherein the file comprises a listing of the items sorted into categories comprising the at least one user-defined category based on product information for display at the consumer computer.

2. (Original) The method of claim 1, wherein the receipt comprises a credit card receipt.

3. (Original) The method of claim 1, wherein the receipt comprises an image of the consumer's signature.

4. (Original) The method of claim 1, wherein the receipt is printed on paper at a point of sale and electronically capturing comprises scanning an image of the receipt to an electronic file.

5. (Previously Presented) The method of claim 1, wherein electronically capturing comprises receiving a file from a point-of-sale device, wherein the file comprises an image of the consumer's signature.

6. (Canceled)

7. (Previously Presented) The method of claim 1, further comprising:
receiving a selection of the purchase item from the consumer;
consulting a database for information about the item; and
transmitting a file comprising the information to the consumer.

8. (Canceled)

9. (Previously Presented) The method of claim 1, wherein the second electronic file comprises programming that causes at least one item to appear as a selectable link to more detailed information about the item.

10. (Canceled)

11. (Previously Presented) A system for presenting an image of a receipt to a consumer, comprising:

a host computer system, including a product information database for storing product information that is retrievable via an identifier relating to an item; and
an interface through which the host computer system communicates with at least one consumer computer;

wherein the host computer system is programmed to:

receive an electronically-captured receipt;

store the receipt;

receive a request from a computer of the consumer to display the image of the receipt; and

transmit an electronic file comprising the image of the receipt for display at the consumer computer.

12. (Original) The system of claim 11, wherein the receipt comprises a credit card receipt.

13. (Original) The system of claim 11, wherein the host computer system further comprises an image capture device configured to electronically capture receipt images.

14. (Original) The system of claim 13, wherein the image capture device is further configured to convert image information captured from a receipt into data, whereby the data may appear in an electronic image of the receipt as a selectable link relating to the data.

15. (Original) The system of claim 11, wherein the interface is configured to provide communication between the host computer system and at least one point-of-sale device.

16. (Canceled)

17. (Previously Presented) The system of claim 11, wherein the identifier is selected from the group consisting of UPC and SKU.

18. (Previously Presented) A system for presenting an image of a receipt to a consumer, comprising:

- means for receiving an electronic image of a receipt;
- means for storing the image;
- means for receiving a request from a computer relating to the consumer to display the image;
- means for transmitting the image to the consumer computer;
- means for obtaining product information relating to an item on the receipt; and
- means for categorizing a plurality of items on a receipt into user-definable categories according to the product information.

19-20. (Canceled)

21. (Previously Presented) A method of presenting receipt information to a consumer, comprising:

- receiving from a consumer computer information that defines at least one user-defined category;
- receiving a request at the host computer from the computer of the consumer to display a categorical listing of items purchased by the consumer, wherein the items are comprised by a plurality of receipts;
- for each of the plurality of receipts, consulting a database for information relating to each item of the receipt;
- using the information to sort the items into categories comprising the at least one user-defined category; and
- transmitting an electronic file from the host computer system to the consumer computer, the electronic file comprising a list of the items sorted into categories comprising the at least one user-defined category for display at the consumer computer.

22. (Canceled)

23. (Previously Presented) The method of claim 21, wherein the electronic file comprises programming that causes at least one item to appear as a selectable link to more detailed information about the item.

10. Evidence Appendix

No additional evidence is provided.

11. Related Proceedings Appendix

No additional proceedings are in process.